

### **REMARKS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

#### **Rejection of Claims 1, 3-9 and 11-26 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 1, 3-9 and 11-26 under 35 U.S.C. §103(a) as being unpatentable over Kephart et al. (U.S. Patent No. 6,026,445) ("Kephart et al.") in view of Barry et al. (U.S. Patent No. 5,293,644) ("Barry et al."). Applicant respectfully traverses this rejection and submits that one of skill in the art would not have sufficient motivation or suggestion to combine Applicant's admitted art with Kephart et al. and Barry et al.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01.

Furthermore, if the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). MPEP 2143.01.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

With these principles in mind Applicant respectfully submits that by preponderance of the evidence one of skill in the art would not have sufficient motivation or suggestion to combine these references. First, the Office Action submits that it would be obvious to one of skill in the art to provide the teachings of Kephart et al. into the system of Applicant's admitted prior art in

order to provide a system and method for saving and reusing name and address mapping, citing Kephart et al. column 1, lines 6-9. Applicant respectfully submits that one of skill in the art would not have sufficient motivation to combine Kephart et al. with Applicant's admitted art. For example, in the background art section of the application, pages 1-8, we introduce Bluetooth technology in which the code name for technological specification for short-range radio links that will allow many proprietary cables that connect devices to one another to be replaced with short range radio links. Throughout pages 1-8 we discuss some of the limitations of the process of discovering devices using Bluetooth device addresses. Then on page 4, starting at line 1, we note that initiator device 20 can receive an inquiry response from multiple Bluetooth devices providing each devices numerical address at least. In that case, a user will not be able to identify one type of responding device over another based only on the devices numerical address. For example, there may be two printers in proximity and the user will generally not be able to tell which printer to connect with based on the numerical address. However, user friendly names can be used to identify each printer's location and features allowing the user to make a selection of one over the other. Therefore, the initiator device needs to discover and display the user friendly name of each of the devices that responded so that the user can select the appropriate device with which to connect. A number of the disadvantages of the Bluetooth approach have been identified, for example, on pages 5, 6 and 8, we discuss the need to look for solutions to problems within the Bluetooth specification and how any solution to the prior art problems of Bluetooth should be satisfactorily consistent with the Bluetooth specification or it should be solution that can be incorporated into legacy Bluetooth devices. Accordingly, it is easily recognizable that the background art discussed in the present application is replete with references to how the Bluetooth specification is used to discover and interact with various devices.

In contrast to the Bluetooth specification is the teachings of Kephart et al. in which even in the Abstract, one is first introduced to an invention which saves and reuses recently acquired Internet addresses. They discuss in the Abstract how, when a client computer receives an internet address for a particular computer name, the computer name and its corresponding internet address are saved in a client memory area. Before sending a request to a name server, the client memory is checked to determine if the desired computer name and corresponding internet address are stored in the client memory. If so, the stored internet address is used to access the desired machine. If the desired computer name and corresponding internet address are not stored in the client memory, then the requested computer name is sent to the name server for conversion. The name server passes the internet address back to the client where it is used to access the machine, and is also stored in the client memory for future use. The client memory area may be configured such that each user has his or her own private memory area where only that user's name and address pairs are stored. In this case, the name address pairs are stored in individual memory areas rather than a client memory area. The invention of Kephart et al. allows up-to-date internet addresses to be obtained quickly and efficiently. Further, if a client determines that the name server is unavailable, the client may continue to store internet addresses and to access desired computers even though the server may be offline.

It is simply clear from the Abstract of Kephart et al. and the background and summary of the invention in columns 1 and 2 that the context of Kephart et al. is the Internet. For example, column 1, lines 23-32, it discusses how each computer has a unique address referred to as the machines Internet address or IP address. These terms are often used interchangeably and they further highlight the machines internet address is a 32-bit address defined by the internet protocol and is typically expressed in a dot notation. The interaction between a server and a client is further discussed in column 1 using the Hypertext Transfer Protocol (HTTP) and the Hypertext

Markup Language (HTML) which provides the basic document formatting and allows a developer to specifically link to other computers and files. Applicant's basic point is that the prior art discussion in the present application is entirely focused on Bluetooth technology and the Bluetooth specification and how it is problematic when multiple devices are trying to simultaneously interact. In stark contrast is Kephart et al. which clearly simply relate to the Internet and a client/user context using the various protocols that are involved in identifying servers and transmitting and displaying data using those protocols. One of skill in the art would easily recognize that there are vast technical differences between these two approaches and by a preponderance of the evidence Applicant respectfully submits that one of skill in the art would not have motivation to take basic principles relating to the internet and the known client and server interaction techniques and blend those with the Bluetooth protocol. For example, there is no conflict issue of multiple clients accessing a server or a website at the same time as are found in Bluetooth.

Accordingly, Applicant respectfully submits that because Kephart et al. should not be combined with Applicant's admitted prior art, that claims 1, 3-9 and 11-26 are patentable and in condition for allowance.

Another glaring problem with the analysis in the Office Action is the inclusion of the Barry et al. reference. The Office Action on page 4 asserts that it would be obvious to one of ordinary skill in the art to provide the teachings of Barry et al. into the system of Applicant's admitted prior art and Kephart et al. in order to provide a method and apparatus that enables an RF communication system to efficiently support subfleet calls for both voice and data communications, citing Barry et al., column 2, lines 25-29. Applicant respectfully notes that because Applicant's admitted prior art is exclusively focused on Bluetooth that one of skill in the art would recognize that the data range of Bluetooth is very limited such that devices have to be

in close proximity to one another as a basic technical feature of Bluetooth. The teachings of Barry et al. relate to an RF communication system which includes communication units such as portable radios that are deployed in units such as buses, trains, trucks, snowplows, security vehicles and so forth. Such fleets may be spread over a large area and the example given in column 1 of the reference is that each city may have ten divisions of vehicles and each division may have 20-30 depots. And each depot will have numerous tow trucks, snowplows, security vehicles, buses and trains. And these vehicles are disbursed among various bus routes or train routes near the depot. First of all, Applicant would respectfully assert that this is simply non-analogous art to the present invention which is in the context of Bluetooth even though claim 1 does not explicitly recite the Bluetooth protocol. However, in terms of analysis of whether it is obvious to combine Barry et al. with Applicant's admitted prior art and Kephart et al., it is easily identifiable that the basic principles of operation of any of these references would have to be dramatically altered if these references were combined. The RF communication system of Barry et al. enables a long distance communication means in the context of vehicle fleets traveling in a disbursed area. Such application clearly is not applicable in a Bluetooth environment and accordingly one of skill in the art would easily recognize the dramatic differences in technology, capability, scope of coverage between and RF communication system and a Bluetooth environment.

Furthermore, one of skill in the art would recognize an entirely different approach that is used in the internet using the Internet protocol and other protocols discussed above relative to communication of the Internet and given the complete difference in International classes and U.S. classes between Barry et al. and Kephart et al. Applicant, therefore, respectfully submits that easily by the preponderance of the evidence one of skill in the art would not have sufficient motivation or suggestion to combine Barry et al. with either Applicant's admitted art or Kephart

et al. Accordingly, for this additional reason, Applicant respectfully submits that claims 1, 3-9 and 11-26 are patentable and in condition for allowance.

**CONCLUSION**

Having addressed all rejections and objections, Applicant respectfully submits that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Deposit Account No. 50-3102** for any deficiency or overpayment.

Respectfully submitted,

Date: January 2, 2007

By:  \_\_\_\_\_

Correspondence Address:  
Customer No. 49637

Thomas M. Isaacson

Attorney for Applicant  
Reg. No. 44,166  
Phone: 410-286-9405  
Fax No.: 410-510-1433